Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte NORMAN TERRY, ELIZABETH PILON-SMITS, and YONG LIAN ZHU

Appeal No. 2002-0252
Application No. 09/365,349

ON BRIEF

Before WILLIAM F. SMITH, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellants request rehearing of the board's decision entered July 31, 2003, wherein the examiner's rejection of appealed claims 1, 2, 5-8, 13-15, 19, 20 and 22 under 35 U.S.C. § 112, first paragraph, was affirmed.

In effect, appellants' request is premised upon assertions that the board failed to consider and properly weigh the arguments in the reply brief that appellants "do know why Noctor et al.'s experiments did not show hyper accumulation." Request for Rehearing, page 1. Appellant's are arguing that Noctor did not have the benefit of the instant specification, and that when the

same laboratory published their completed experiments, their ECS-overexpressing poplar "did indeed provide higher cadmium accumulation than corresponding untransformed plants," and that the full report had the benefit of Appellants teachings.

We cannot find, nor do appellants point to, however, anyplace in the record on appeal where the Arisi reference relied upon in the Request for Rehearing had been earlier presented, and we refuse to consider it at this time. See, e.g., MPEP 1214.03.

Moreover, as noted by the Request for Rehearing, appellants' argument in the reply brief is that they did not know how the Noctor reference performed its experiments, therefore appellants asserted they could not determine why Noctor failed. See Request for Rehearing, page 1. We reiterate, however, the specification provides no supporting data for the results for the hyperaccumulating poplars presented in the table at pages 7 and 8 of the specification, and thus we are unable to determine how the poplars produced by Arisi differ from the poplars presented in the table. Decision on Appeal, pages 11-12.

We have carefully reviewed the original opinion in light of appellants' request, but we find no point of law or fact which we overlooked or misapprehended in arriving at our decision. To the extent relevant, appellants' request amounts to a reargument of points already considered by the board.

Therefore, appellants' request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the examiner's rejection under 35 U.S.C. § 112, first paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING DENIED

William F. Smith)
Administrative Patent Judge)
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Donald E. Adams) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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Lora M. Green)
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